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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,080	11/20/2003	David L. Burnett	56464-00005USPT	8637
23932	7590	05/09/2006	EXAMINER	
JENKENS & GILCHRIST, PC 1445 ROSS AVENUE SUITE 3200 DALLAS, TX 75202			MORAN, KATHERINE M	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/718,080	Applicant(s) BURNETT ET AL.	
	Examiner Katherine Moran	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 24-26 and 31-33 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 14, 16-23, 27-30, 34 and 36-38 is/are rejected.
- 7) ☒ Claim(s) 12 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendment of 3/3/06 has been received and reviewed. Claims 1, 7, 10, 20, 22, and 34-36 are amended and claims 39-42 are cancelled. Claims 1-38 are pending with claims 24-26 and 31-33 withdrawn.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of ribs in combination with ridges on an interior region, with the ridges of different lengths (claim 36) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. This particular combination is also not disclosed in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office Action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-11, 13, 14, 16, 18-21, 27-30, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Bignon et al. (US 2003/0126669). Bignon discloses the invention as claimed. Bignon teaches a hand protector and grip enhancer 10 comprising a generally C-shaped body defining an interior region including a plurality of ribs 27 that bridge across a hinge region (the region shown in Figure 7 which extends between the finger and thumb pockets) and extend in a generally perpendicular direction from the hinge region towards a first end and a second end of the body. The body includes a finger receiving pocket 20 at a first end 26 of the body and a thumb receiving pocket 30 at the second end of the body. The C-shaped body is shown in Figures 6 and 7 and the plurality of ribs configuration extends towards the first and

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second ends. The device 10 is made of silicone which has low thermal conductivity and possesses an inherent anti-slip characteristic. The C-shaped body is heat resistant and is flexible about the hinge region between the first and second ends. The hinge region is shaped to substantially conform to a user's palm and the hinge region has a substantially convex outer surface shape defined by the plurality of ribs. The hinge region has a substantially flat outer surface shape. The length of the body from the hinge region to the first end is sized to generally conform to a length of a user's hand from a palm region to finger tips. The length of the body from the hinge region to the second end is sized to generally conform to a length of a user's hand from a palm region to a tip of the user's thumb. A length of the finger receiving pocket extending from the hinge region to the first end is not similar to a length of the thumb receiving pocket extending from the hinge region to the second end. Each pocket includes a flap- in this case, the flap is defined by the supporting pocket structure on an underside of the ribs or on the opposing pocket side. The flap is integrally formed with the body and the ribs run along a first wall 25 and second wall 27 extending from the hinge region. At least two of the ribs are of different lengths as shown in Figure 6. The finger and thumb pockets 20,26 are substantially similar in shape since both are formed into a rounded shape. It could also be said that the pockets are not similar in shape since the finger pocket is wider than the thumb pocket. The first and second ends include a lip 24 which has a substantially flat tip shape.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bignon in view of Koffler (U.S.1,990,553). Bignon discloses the invention substantially as claimed. However, Bignon doesn't teach a body formed from elastomeric material or rubber. Koffler teaches a rubber hand protector and grip enhancer comprising a generally C-shaped body, a finger receiving pocket 10 at a first end of the body and a thumb receiving pocket 11 at a second end of the body. The rubber device is heat resistant, has low thermal conductivity and an inherent anti-slip characteristic. Applicant's specification does not provide unforeseeable results achieved by employing one type of material over another and states that any material having low thermal

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conductivity and anti-slip properties would be desirable. Rubber and silicone are functionally equivalent. Therefore, it would have been obvious to form Bignon's device from rubber since rubber is a heat-resistant and resilient material.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bignon in view of Uhri (U.S. 1,955,989). Bignon discloses the invention substantially as claimed. However, Bignon doesn't teach finger and thumb receiving pockets including holes to permit air flow and drainage. Uhri teaches a hand device with holes 10 at finger and thumb pockets 3,4 for water drainage. Therefore, it would have been obvious to provide Bignon's pockets with the holes taught by Uhri, because Uhri teaches this is desirable in order to allow for water drainage.

7. Claims 22, 23, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bignon in view of Stelzen (U.S. 3,181,198). Bignon discloses the invention substantially as claimed. However, Bignon doesn't teach the body comprising a plurality of bumps and ridges and a plurality of discrete protruberances on first and second wall surfaces, with the ridges being of different lengths. Stelzen teaches a body portion with ribs 24 extending from a hinge region 22 and comprising bumps and ridges 26. It would have been obvious to also provide protuberances so that the coefficient of friction of the walls is increased. Having ridges of different lengths would achieve various gripping forces at different regions of the interior. Therefore, it would have been obvious to one of ordinary skill in the art to provide Bignon's interior region with ribs, bumps and ridges of different lengths and protuberances, to increase the versatility of the device to perform various operations on an object being gripped by the device.

Allowable Subject Matter

8. Claims 12 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claim 35 is allowed because the prior art doesn't teach a generally C-shaped body having an interior region with a plurality of ribs that bridge across a hinge region and extend generally perpendicularly from the hinge region towards a first end and a second end of the body, with the finger and thumb receiving pockets at first and second ends of the body respectively, and the ribs increasing in length and height towards a center of the hinge region.

Response to Arguments

10. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection prompted by the claim amendments.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (571) 273-8300. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'K Moran', with a stylized, flowing script.

Katherine Moran
Primary Examiner
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Kmm

May 3, 2006